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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/610,812	07/06/2000	Takanori Fujii	2271/62536	5077

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EXAMINER

LE, HIEU C

ART UNIT	PAPER NUMBER
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2142

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DATE MAILED: 06/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/610,812

Applicant(s)

TAKANORI FUJII

Examiner

Hieu c. Le

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-68 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7, 8, 10, 12-14, 16, 18, 19 and 21 is/are rejected.
- 7) ☒ Claim(s) 4, 6, 9, 11, 15, 17, 20, 22-68 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

1. The amendment filed 4/17/04 have been entered and made of record.
2. The Applicant 's argument filed 4/17/04 have been fully considered but they are not persuasive for the following reasons:

Applicant alleges that " more specifically, Applicants find no teaching [,]" (p. 26, lines 8-12). The Examiner disagrees. Firstly, the Examiner can not find anywhere in claim 1, a power saving control unit configured to cancel the power saving mode of an electronic mail device upon electronic mail reception. Claim 1, recites " to cancel the power-saving mode when said device detects that a second power saving condition is satisfied" . Secondly, Kohama discloses a control unit 24 judges whether or not the execution of certain operation (event) has been detected by the monitor unit 26 and in case where it has been detected (Y) (second condition is satisfied), the timer 28 (i.e. cancel the power cut off) (p. 40, lines 18-23) which reads on the claim as broadly claimed.

Applicant alleges that " In contrast, according the present application, the second power saving condition [,]" (p. 27, lines 9-18). The Examiner disagrees. Firstly, as discussed above Kohama discloses, judging whether or not the execution of certain operation (event occurrence) has been detected and upon the detection (i.e. occurrence of event), resets the timer 28 (i.e cancel the power cut off) . Secondly, as discussed above, the Examiner can not find any where in the claim language that the power saving mode is canceled upon electronic mail reception. Third, Sujita also discloses that power saving state is reset (i.e. the power saving mode is canceled) only when the calling signal (an event) is received (i.e event occurs) (col. 2, lines 11-16).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3, 5, 12-14, 16 are rejected under 35 U.S.C. 102(b) as anticipated by Tsuyotaka Kohama et al [Japanese Patent Publication Hei 10-91294].

As to claim 1, Tsuyotaka discloses an electronic mail terminal device (Fig. 1, item 20) that transmits and receives information through electronic mail, comprising:

a communication unit connected to a network and performing electronic mail data exchange via the network [client device 20 possesses a circuit line IF (21) (interface) which executes routines for transmitting and received mail via LAN (network) (p. 38, lines 14-17)]; and

a power-saving control unit [control unit (24) in Fig. 1] configured to set the communication unit and said device into a power-saving mode when said device detects that a first power-saving condition is satisfied, [a monitor unit (26) monitor whether or not a certain operation has been executed by the user of the device (20) whereas upon the detection of the execution of certain operation, the control unit (24) sets the timer 28 (step 202). At step 206, the control unit 24 judges whether or not the execution of certain operation has been detected by monitor unit 26 and in case it has

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been detected (N). In step 208, it is determined whether or not a notification of the overdue of the preliminarily designated period has been received (a first power saving condition is satisfied) and in case it has been received (Y) advance to step 210. In step 210 the control unit 24 controls cut off (shut down) of the electric power of the device (power saving mode) (p. 40, lines 6-p. 412, line 20)], and power saving control unit being configured to cancels the power saving mode when said device detects that a second power-saving timing condition is satisfied [at step 206, the control unit 24 judges whether or not the execution of certain operation has been detected by the monitor unit 26 and in a case where it has been detected (Y) (second power saving condition is satisfied) advanced to step 214 to reset the timer 28. (i.e. cancel the power cut off) (p. 40, line 18-23)].

As to claim 2, Tsuyotaka further discloses wherein:

The communication unit is a local area network communication unit that is connected to a local area network and performs electronic data exchange via the local area network (Fig. 1; item 21, p.38, lines 14-19).

the first power-saving timing condition is that a stand-by state lasts longer than a predetermined period of time (p. 40, lines 13-17); and

the second power-saving timing condition is that an event occurs (p. 40, lines 18-20).

As to claim 3, Tsuyotaka further discloses wherein

the power-saving control unit cancels the power-saving mode at predetermined mail fetching intervals so as to fetch electronic mail addressed to said device through

the local area network communication unit [the control unit 26 of the client device 20 inquire the mail management unit 12 of the server device to 10 routinely or periodically (i.e. at predetermined mail fetching intervals) via interface IF 21, LAN 15 and transmission reception unit 15 of the reception of a mail(s) addressed to the client device 20 (p. 42, lines 6-13). At step 214, the control unit 24 displays a mail arrival message on the display and initializing the electric power of the client device 20 (cancel the power saving mode to fetch e-mail) (p. 43, lines 8-17)].

As to claim 5, Tsuyotaka further discloses wherein the mail fetching intervals can be set at will [periodically or routinely fetching e-mail (set at will) (p. 42, lines 6-11)].

Claim 12 is a method analogous to the system of claim 1, arguments analogous to those applied to claim 1 are applied to claim 12.

Claim 13 is a method analogous to the system of claim 2, arguments analogous to those applied to claim 2 are applied to claim 13.

Claim 14 is a method analogous to the system of claim 3, arguments analogous to those applied to claim 3 are applied to claim 14.

Claim 16 is a method analogous to the system of claim 5, arguments analogous to those applied to claim 5 are applied to claim 16.

Claim Rejections - 35 U.S.C. § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art

to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 7-8,10, 18-19,21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuyotaka Kohama et al [Japanese Patent Publication Hei 10-91294] and in view of Sujita (US.Pat. 5,764,864).

As to claim 7, refer to claim 2 rejection. Tsuyotaka further discloses access to a service provide [Fig. 1, server 10]. Tsuyotaka discloses a communication network such as a LAN or WAN for accessing the server 10.

Tsuyotaka does not explicitly disclose a dial up access to an Internet service provider via a public network.

Sujita discloses a facsimile machine which can selectively set one of a plurality of modes. The fax machine equipped with a power saving function (Abstract). The fax machine using a call connection via a modem (dial up) to receive data (col. 3, lines 11-15).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Sujita's teachings to modify Tsuyotaka's method by using a fax machine that uses a dial up signal as power saving signal to control the machine so that power saving state is reset only when the calling signal is received.

As to claim 8, refer to claim 3 rejection. Tsuyotaka further discloses wherein the power-saving control unit cancels the power saving mode at predetermined mail fetching intervals so as to fetch electronic mail addressed to the device through the dialup communication unit.

Tsuyotaka discloses a communication network such as a LAN or WAN for accessing the server 10.

Tsuyotaka does not explicitly disclose a dial up access to an Internet service provider via a public network. Sujita discloses a facsimile machine which can selectively set one of a plurality of modes. The fax machine equipped with a power saving function (Abstract). The fax machine using a call connection via a modem (dial up) to receive data (col. 3, lines 11-15).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Sujita's teachings to modify Tsuyotaka's method by using a fax machine that uses a dial up signal as power saving signal to control the machine so that power saving state is reset only when the calling signal is received.

As to claim 10, refer to claim 5 rejection.

Claim 18 is a method analogous to the system of claim 7, arguments analogous to those applied to claim 7 are applied to claim 18.

Claim 19 is a method analogous to the system of claim 8, arguments analogous to those applied to claim 8 are applied to claim 19.

As to claim 21, refer to claim 5 rejection.

Allowable Subject Matter

7. Claims 4,6,9,11,15,17,20,22-69 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hieu Le whose telephone number is (703) 306-3101. The examiner can normally be reached on Monday to Friday from 7:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Harvey, can be reached on (703) 305-9703. The fax phone number for this Group is (703) 308-9051.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Hieu Le


JACK B. HARVEY
SUPERVISORY PATENT EXAMINER